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Paper No. 6

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OFFICE OF PETITIONS

In re Application of
Amir Aliabadi et al.
Application No. 09/882,368
Filed: June 15, 2001
Attorney Docket No. INFS-1-17535

ON PETITION

This is in response to the petition under 37 CFR 1.47(a), filed October 1, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) set forth above.

As to item (1), petitioner has not provided sufficient evidence that a copy of the application papers was sent or given to the non-signing inventor. Petitioner must show proof that a copy of the application (specification, claims and drawings) was sent or given to the non-signing inventor for review. Rule 47 applicant has failed to show or provide proof that the nonsigning inventor has refused to sign the declaration, after having been presented with a copy of the application papers. Did inventor Kelvin Moeller receive the application papers? See Manual of Patent

Examining Procedure, Section 409.03(d). While the petition indicates that the declaration and assignment forms were mailed to inventor Moeller, no evidence has been presented to show that a copy of the complete application papers was in fact presented to Mr. Moeller. Before a refusal can be alleged, it must be demonstrated that a copy of the application papers was presented to the nonsigning inventor. If joint inventor Moeller was not presented with a copy of the application papers, then Mr. Moeller could not attest that he has "reviewed and understands the application papers" and could not execute that declaration he was requested to sign. Therefore, unless petitioner can show that a copy of the application papers was presented to inventor Moeller, then petitioner will have to mail a copy of the complete application papers (specification, claims and drawings) to inventor Moeller's last known address, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc. See MPEP 409.03(d).

The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. If the inventor orally refuses to join in the application, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. If, on the other hand, petitioner receives an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 petitioner that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to submit the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Irvin Dingle.


Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
 Box DAC
 P.O. Box 2327
 Arlington, VA 22202

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Irvin Dingle at (703) 306-5684.


Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy